

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on July 13, 2005, the Examiner allowed claims 1, 3 and 4. The Examiner rejected claims 5-15, 17-35 and also objected to the drawings and specification. Applicants respectfully provide the following in response to the Examiner's objections and rejections.

Objections to the Drawings

The Examiner objected to the drawings under 37 CFR §1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Examiner said the "major axis of the resilient biasing member and its tension load and compression load as now claimed in claim 8" and the "first and second substantially triangular side panel biasing means and side panels made of elastic material, as now claimed in new claim 32" are not shown. In response, Applicants have amended the language of claim 8 to read "vertical" axis, and respectfully direct the Examiner to Figures 2 and 3B, which show how the biasing means taught and claimed by claim 8 is compressed along the lower portion of its vertical axis and stretched (providing tension) on the upper portion. In addition, Applicants respectfully direct the Examiner to Figures 1-3, which show examples of a substantially triangular (i.e. three-sided) panel. While the embodiments shown could be made of any number of materials, they clearly include stretchable materials, such as elastic. Accordingly, Applicants respectfully request the withdrawal of the Examiner's objections to the drawings.

Claim Rejections Under 35 U.S.C. §112, First Paragraph and Objections to the Specification

The Examiner objected to the specification under 37 CFR §1.75(d)(1) and MPEP §608.01(o) as failing to provide proper antecedent basis for the following language of amended claim 8: the resilient biasing member having a major axis such that it bears a tension load and a compression load. In addition, the Examiner rejected claims 8, 9-14 and 32 under 35 U.S.C. §112, first paragraph, stating:

It isn't clear how applicants consider the U-shaped biasing member to have a major axis or how it bears a tension load and a compression load along that axis, as claimed in amended claim 8. Applicants only mention potential energy with regard to the biasing member. Furthermore it isn't clear how applicants consider the sides to be elastic as claimed in new claim 32. There doesn't appear to be any mention of elastic sides.

With respect to the Examiner's objections and rejections to claim 8, Applicants respectfully submit they have amended claim 8 to read "vertical" axis and also submit that the biasing means taught and claimed by claim 8 is compressed along the lower portion of its vertical axis and stretched (providing tension) on the upper portion. This is readily apparent by Figures 2 and 3B, which show this simultaneous compression and tension activity. In addition, Applicants respectfully direct the Examiner to p. 4, ll. 7-9 and p. 9, ll. 18-20. These passages state:

In addition, the potential energy harnessed by so biasing the resilient member causes the resilient member to automatically seal the pocket opening when the biasing force is removed.

Once such force is removed, however, the potential energy effectively harnessed by the resilient member in the second open position causes the resilient member to immediately spring back to the first closed position.

These passages, together with the drawings, make it clear that opposing forces propel the pocket assembly closed.

With respect to the Examiner's rejection of claim 32, Applicants respectfully direct the Examiner to Figures 1-3, which show examples of a substantially triangular (i.e. three-sided) panel. While the embodiments shown could be made of any number of materials, they clearly include stretchable materials, such as elastic. In addition, Applicants respectfully direct the Examiner to p. 9, ll. 5-7 of the application, which states:

Biasing means 14 may comprise plastic, metal, or any elastomeric or other material known to those in the art capable of being biased to harness potential energy.

(Emphasis added) Thus, Applicants clearly meant for elastic materials to be used in the present invention. Accordingly, Applicants respectfully request for the Examiner to withdraw the objections and rejections based on Section 112, first paragraph, 37 CFR §1.75(d)(1) and MPEP §608.01(o).

Claim Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 5-15, 17-31, 33, 34 and 35 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, as the Examiner describes in detail on pages 5-6 of the Office Action. In response, Applicants have:

- 1) Amended claims 5-7, changing "biasing means" to "biasing rod";
- 2) Amended claim 8, changing "major" to "vertical", as discussed above;
- 3) Amended claims 10 and 14, changing "said bag" to "a bag";

- 4) Amended claims 15, 17, 19, 20, 21, 22, 23, 24, changing “pocket member” to “pocket”;
- 5) Amended claim 8, changing “the pocket” to “said pocket member”;
- 6) Amended claims 28 and 30, changing “said interior” to “an interior”;
 - a. Applicants also respectfully submit “an opening. . .” is not a double inclusion of that claimed in claim 25, rather the limitations of claim 30 are separate and distinct from those of claim 25;
- 7) Amended claims 33, 34, 35, changing “the bottom” to “a bottom”; and
- 8) Amended claim 34, changing “the surface” to “a surface”.

Because of the preceding amendments, Applicants respectfully request for the Examiner to withdraw the rejections based on Section 112, second paragraph.

Claim Rejections under 35 U.S.C. §103(a) in light of Bieber et al. and T. Johnson

The Examiner rejected claims 15, 17, 18, 21, 24, 25-27, 30, 31 and 34 under 35 U.S.C. §103(a), as being unpatentable over Bieber et al. and T. Johnson. Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

In addition, Section 103 specifically requires assessment of the invention "as a whole." The Federal Circuit has explained that inventions typically are new combinations of existing principles or features. Env'l. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements"). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275 (Fed. Cir. 2004). The Federal Circuit further explained that

[w]ithout this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. Id. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. Id. (emphasis added).

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. Id. This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. Id. (emphasis added). In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. See In re Rouffet, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Princeton Biochemicals Inc. v. Beckman Coulter Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Applicants respectfully submit the Examiner's retention of this rejection based on the flexible/rigid distinction is inappropriate under Section 103(a). This distinction is only one of many distinctions made by Applicants (e.g. see pp. 19-22 of Applicants' previous response). Under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no

knowledge of the present invention, an artisan of ordinary skill would not have combined Bieber et al. and T. Johnson in the claimed manner. Only by using the roadmap of the present invention would an artisan of ordinary skill combine these two references in such a manner. As discussed in the previous response, the wire loop of Bieber et al. would not allow the accordion-like paper section of T. Johnson to open and close properly. Thus, the combination does not suggest the claimed invention's limitations to close the pocket (see claims 15 and 25) and for the flexible rod to contact the surface of the bag (see claim 34). Neither the pocket of Bieber et al. nor the pocket of T. Johnson closes as a result of the biasing element or has a flexible rod that contacts the surface of the bag. Rather Bieber et al.'s attaché case and T. Johnson's brief case use an additional element to close their respective pockets (i.e. Bieber et al.'s entire brief case closes and T. Johnson's flap encloses its pocket.). Consequently, not only is there no suggestion to combine, but the combination also fails to disclose the above-mentioned pocket closing and flexible rod contacting limitations.

Accordingly, Applicants respectfully request withdrawal of the rejections of claims 15, 17, 18, 21, 24, 25-27, 30, 31 and 34 under 35 USC §103(a), as being unpatentable over Bieber et al. and T. Johnson.

Claim Rejections under 35 U.S.C. §103(a) in light of Bieber et al. and T. Johnson and further in view of Alter

The Examiner rejected claims 23 and 28 under 35 U.S.C. §103(a), as being unpatentable over Bieber et al. and T. Johnson and further in view of Alter. Applicants respectfully traverse

this rejection in light of the arguments above relating to independent claims 15 and 25, from which claims 23 and 28 depend, respectively.

Claim Rejections under 35 U.S.C. §103(a) in light of Horiuchi and Bieber et al.

The Examiner rejected claims 15, 17, 18, 21, 24, 25-27, 30 and 31, under 35 U.S.C. §103(a), as being unpatentable over Horiuchi in view of Bieber et al. Applicants respectfully traverse this rejection, as hereinafter set forth. Once again, Applicants respectfully submit that the Examiner used the present invention as a roadmap to inappropriately combine the above-mentioned references. Under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no knowledge of the present invention, an artisan of ordinary skill would not have combined Horiuchi and Bieber et al. in the claimed manner. First, closing Horiuchi's pocket in the manner taught by Bieber et al. does not satisfy all of the elements of the claimed invention because, as discussed above, Bieber et al.'s pocket does not close as a result of the biasing element (see claims 15 and 25). Rather Bieber et al.'s attaché case uses an additional element (the closure of the entire brief case) to close its pocket. Second, Bieber et al. teaches away from claim 25's limitation to couple to a front panel at least one elongate biasing member. Bieber et al. explicitly requires its wire to be riveted to the lid rear wall.

Therefore, because the combination of Bieber et al. and Horiuchi fail to teach every aspect of independent claims 15 and 25, and also teach away from the present invention, Applicants respectfully request the Examiner withdraw the rejection under Section 103. Because claims 17, 18, 21, 24 and 26, 27, 30, 31 depend from claims 15 and 25 respectively, Applicant likewise requests the Examiner withdraw the rejection to these claims under Section 103.

Claim Rejection under 35 U.S.C. §102(a) in light of Chi, or in the alternative, under 35 U.S.C. §103(a) in light of Chi

The Examiner rejected claim 32 under 35 U.S.C. § 102(a) as anticipated by Chi. Applicants respectfully traverse this ground of rejection.

An invention is unpatentable under Section 102(a) if “the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.” A Section 102(a) rejection is only appropriate, however, where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). For the reasons set forth below, Applicants submit that Chi does not teach each and every element of the claimed invention, and thus does not anticipate the present invention.

Applicants respectfully submit that Chi does not disclose claim 32’s biasing means. In stark contrast to Applicants’ biasing means, which is resilient and automatically seals the pocket opening when the biasing force is removed (see Application, p. 4, ll. 7-9), Chi’s compressive element 14 must be manually tightened by a strap or lever. Chi, paragraphs 16 and 19. Thus, not only does Chi fail to teach each and every element under Section 102, it also teaches away from the present invention under Section 103, by disclosing a pocket that is more time and labor intensive to use than the prior art. In contrast, Applicants’ device “facilitates quick and easy access to items contained within [the] pocket” (Application, p. 5, l. 10) and overcomes the labor intensive pocket closure devices that use zippers and straps (Application, p. 2, ll. 14-15).

Accordingly, as Chi fails to disclose each and every element of the claimed invention and also teaches away, it fails to anticipate the claimed invention under Section 102(a) and make the invention obvious under Section 103(a). Therefore, Applicants respectfully request withdrawal of the rejection of claim 32 under Sections 102(a) and 103(a).

Claim Rejections under 35 U.S.C. §102(b) in light of Soskin

The Examiner rejected claims 33 and 35 under 35 U.S.C. § 102(b) as anticipated by Soskin. Applicants have amended claims 33 and 35 to include a biasing means that pivotally closes the pocket. Accordingly, as Soskin does not disclose the biasing means of claims 33 and 35, it fails to anticipate the claimed invention under Section 102(b). Therefore, Applicants respectfully request withdrawal of the rejections of claims 33 and 35 under Section 102(b).

CONCLUSION

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

DATED this 13 day of October, 2005.

Respectfully submitted,

Michael F. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
(801) 328-3600

SBO/rh

855867/01